

REMARKS

Claims 1, 5, 15, 22 and 36-50 are pending in the present application. Claims 1, 36-39 and 45 are independent claims. Claims 5, 15, and 22 are amended. Claims 2-4, 6-14, 16-21, and 23-35 were previously cancelled.

Objections to the Specification

The specification is objected to for allegedly failing to provide proper antecedent basis for the claimed subject matter. The specification allegedly fails to provide antecedent basis for a “computer readable storage medium” in claim 1, and “computer readable medium” in claims 5, 15, and 22.

The Applicant respectfully disagrees. As stated in the last response on pages 11 and 12, the specification and figures clearly show and describe a “computer readable storage medium” and a “computer readable medium.” The specification in many places refers to an optical disc such as a Blu-Ray disc rewritable (BD-RW). See, for example, paragraphs [0004] and [0035] of the published patent application for the present application.

Furthermore, FIG. 7 illustrates a schematic diagram of an embodiment of an optical disc recording and reproducing apparatus which in some embodiments may be a computer reading an optical disc. One skilled in the art would understand the disc identified by reference character 1 in FIG. 7 to be a computer readable recording medium. See also paragraph [0050] through paragraph [0053] of the patent application publication for the present application. Furthermore, the term recording medium is found in the as filed claims which are part of the specification.

For at least these reasons, the Applicant respectfully asserts that the term “a computer readable recording medium” is supported by the specification. However, to

forward prosecution, the Applicant amends claims 5, 15, and 22 to include the phrase "a computer readable storage medium." The Applicant respectfully asserts that the specification does provide proper antecedent basis for the claimed subject matter. The Applicant respectfully requests that the objections to the specification be removed.

Claim Rejections – 35 U.S.C. §112, Second Paragraph

Claims 5, 15 and 22 are rejected under 35 U.S.C. §112, second paragraph, because they recite the limitation "computer-readable medium." There is allegedly insufficient antecedent basis for this limitation. The Applicant respectfully disagrees with the Examiner that there is an insufficient antecedent basis for the term "computer readable medium." However, to forward prosecution, claims 5, 15, and 22 have been amended to recite the term "the computer readable storage medium" as found in claim 1. Therefore, claim 1 provides antecedent basis for this term in claims 5, 15, and 22. For at least this reason, the Applicant respectfully requests that the rejections under 35 U.S.C. §112, second paragraph, be removed.

Claim Rejections – 35 U.S.C. §101

Claims 1, 5, 15 and 22 are rejected under 35 U.S.C. §101 because the claims are allegedly directed to non-statutory subject matter. The Applicant respectfully traverses these rejections.

On page 2 of the Office Action, the Office Action alleges that with respect to the 35 U.S.C. §101 rejection in the previous amendment filed January 15, 2009, the Applicant did not address the issue of the Examiner treating the claimed medium as a signal. The Applicant respectfully disagrees with this assertion. In the Amendment filed January 15, 2009, claim 1 was amended to read "a computer readable storage

medium." A signal cannot be a computer readable storage medium because a signal is not a storage medium. As described above, the specification and figures as filed, provide antecedent basis for a computer readable storage medium by showing and describing optical discs configured to store data and be read by a computer. The Applicant respectfully asserts that a physical storage medium such as an optical disc is statutory subject matter. For at least this reason, the Applicant respectfully requests that the rejections under 35 U.S.C. §101 of claims 1, 5, 15, and 22 be removed.

Claim Rejections – 35 U.S.C. §103

Claims 1, 5, 15, 22 and 36-50 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 7,000,246 to Takao ("Takao") in view of U.S. Patent 5,870,523 to Kikuchi et al. ("Kikuchi") and further in view of U.S. Patent Publication 2004/0088739 to Shimoji et al. ("Shimoji"). The Applicant respectfully traverses this rejection.

According to the new Examination Guidelines for Determining Obviousness under 35 U.S.C. § 103 in view of the Supreme Court decision of *KSR International, Co. v. Teleflex, Inc.* it is stated that the proper analysis for a determination of obviousness is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the claimed invention would have been obvious. An Office Action must explain why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. See 72 Fed. Reg. 57526, 57528-529 (Oct. 10, 2007).

The Applicant asserts that neither Takao, Kikuchi, nor Shimoji, either separately or in combination, teach, suggest, or otherwise render obvious all of the limitations set forth in the claims. Further, there has been no clear articulation made of why the differences between the prior art and the claims would have been obvious to one of ordinary skill in the art.

For example, independent claim 1 recites, among other things, a "real-time navigation table including ... indication information for indicating the number of real-time playback information within the navigation unit, and wherein each real-time navigation pack has the same pack identification code." The Applicant respectfully asserts that the combination of Takao, Kikuchi, and Shimoji does not teach, suggest, or otherwise render obvious a combination including the language quoted above.

For example, in the Office Action on pages 4 and 5, the Office Action admits that Takao does not teach the above quoted portions of claim 1. In an effort to cure the insufficiencies of Takao, the Office Action on page 5 cites Kikuchi, specifically FIG. 34, col. 20, lns. 35-65 and FIGS. 27-29, col. 19, lns. 5-18. The Office Action alleges that the cell number of Kikuchi corresponds to "indicating the number of real-time playback information" of claim 1.

As discussed in col. 18, lns. 52-57, Kikuchi recites: "The PCI general information (PCI_GI) contains the address (NAV_PCK_LBN) of the NAV pack (NAV_PCK) 86 in which the PCI data is recorded as shown in FIG. 28, the address being expressed in the number of blocks relative to the VOB logical sector in which the PCI data is recorded." Further, as shown in FIG. 34 of Kikuchi, different cells are sequentially numbered. For example, cell number 1, 2, 3, etc., and the cell numbering is the identification or address of the cell. As described in the specification at col. 20, lns. 35-65, Kikuchi describes a system where individual cells are identified by their cell

numbers. Thus, in Kikuchi, the sequential number of the cell is the cell's address. As stated in the Office Action on page 5, the sequence of cell numbers is considered to indicate the number of real-time playback information recited in claim 1.

Assuming that the sequentially numbered cell provides the "number of real-time playback information within the navigation unit" of claim 1, to be correct¹, Kikuchi still does not cure the insufficiencies of Takao. On page 5 and 6 of the Office Action, it is admitted that Takao in view of Kikuchi fails to teach wherein "each real-time navigation packet has a same packet identification code" as recited in claim 1. In an attempt to cure the insufficiencies of Takao and Kikuchi in this regard, the Office Action on page 6 cites Shimoji. The Office Action on page 6 contends that Shimoji teaches where a plurality of real-time navigation packets have the same packet identification code. FIG. 28A of Shimoji is cited to support this allegation.

The Office Action points to the PIDs, the identification number of 0 X 0092, to correspond to the same packet identification code. The Office Action further asserts that it would have obvious for one of ordinary skill in the art at the time of the invention to incorporate the teaching of Shimoji into the teachings of Takao and Kikuchi. Thus, it appears that the Office Action is contending that the feature of Shimoji, of having each real-time navigation packet having the same packet identification code could be applied to Kikuchi where the addresses are IDs of the cell numbers are different. Thus, the Office Action contemplates changing the cell numbers of Kikuchi from being different from each other, to being the same. This modification it is contended then satisfies the quoted language above, claim 1. The Applicant respectfully disagrees.

¹ The Applicant does not acquiesce to nor disagree with this argument at this time, but rather assumes it to be true for the sake of the discussion here. The Applicant reserves the right to contend with the above mentioned assumptions in the future.

The Office Action relies on the different cell numbers of Kikuchi to provide a total count of how many cells are in Kikuchi. In other words, if there are 10 cells and the cells are numbered 1-10, the Office Action relies on the number 10 of the tenth cell to "indicate the number of real-time playback information." If the cell numbers were changed from being different to being the same as taught by Shimoji, then the feature of indicating the number of real-time playback information would be lost. Therefore, the proposed combination of Shimoji, Kikuchi, and Takao does not teach, suggest or otherwise render obvious the language quoted above from claim 1. Specifically, to change the cell numbers of Kikuchi to be the same as taught by Shimoji, as contemplated by the Office Action, the feature of indicating the number of real-time playback information would be lost. Therefore, the combination of Takao, Kikuchi, Shimoji, does not teach, suggest, or otherwise render obvious all the limitations set forth in claim 1.

Further, the proposed modification of changing the cell numbers that are different in Kikuchi to having identical identification codes as taught in Shimoji would render Kikuchi unfit for its intended purpose. If a proposed modification renders the prior art unsatisfactory for its intended purpose, then this is an indicia that the combination of references is not obvious. See for example MPEP § 2143.01 V. As mentioned above, col. 20, lns. 35-65 of Kikuchi explain how the system of Kikuchi relies on the cells having different cell identifications in order to refer to these various cell identifications to perform various functions. If, as contemplated by the Office Action, the different cell numbers of Kikuchi were changed to have the same identifiers as taught in Shimoji, then the methods described in Kikuchi would not work properly because the individual cells could not be refereed by specific cell numbers. Therefore, the proposed modification of combining the same identification numbers of Shimoji

with the cells of Kikuchi would render Kikuchi unsatisfactory for its intended purpose. Therefore, the combination of Shimoji with Kikuchi as described in the Office Action is not obvious.

In view of the arguments set forth above, the Applicant contends that the proposed combination of Takao, Kikuchi, and Shimoji does not teach, suggest, or otherwise render obvious all of the features quoted above of claim 1. Further, the proposed combination of Kikuchi and Shimoji would render Kikuchi unfit for its intended purpose. Such a combination is therefore not obvious. For at least these reasons, the Applicant respectfully asserts that a *prima facie* case of obviousness has not been made and requests that the rejections under 35 U.S.C. 103 of claim 1 and its dependent claims 5, 15, and 22 be removed.

The Applicant respectfully notes that the other independent claims 36-39 and 45 contain language similar to that quoted above with respect to claim 1. Therefore, for at least the reasons set forth above with respect to claim 1, the combination of Takao, Kikuchi, and Shimoji fail to render obvious all of the limitations set forth in claims 36-39 and 45 and their respective dependent claims. Further, the proposed combination of Kikuchi and Shimoji would render Kikuchi unfit for its intended purpose, further indicating that such a combination does not render obvious claims 36-39 and 45 and their respective dependent claims. For at least these reasons, the Applicant respectfully requests that the rejections under 35 U.S.C. 103 of claims 36-39 and 45 be removed.

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CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of claims 1, 5, 15, 22 and 36-50 in connection with the present application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. §1.17; particularly, extension of time fees.

Respectfully submitted,

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